

**REMARKS**

Claims 1-8, 12-19 and 26-27 are pending. By this Amendment, claims 1, 3, 4, 12, 14, 15, 26 and 27 are amended, and claims 9-11, 20-22 and 28 are canceled without prejudice to or disclaimer of the subject matter therein. No new matter is added. Reconsideration in view of the foregoing amendments and the following remarks is respectfully requested.

Applicants thank Examiners Zhou and Nguyen for the courtesies extended to Applicants' representatives during the January 24, 2005 personal interview. During the interview, Applicants' representatives asserted an improper motivation for combination with respect to the rejection of claim 1 and discussed possible amendments in claim 4 for better clarification. Applicants' representatives also agreed to clarify claim 1 and corresponding claims. Examiner Zhou confirmed that she would consider such assertion and amendments upon receipt of a formal response.

The Office Action rejects claims 1-4, 7-8, 12-15, 18-19, and 26-27 under 35 U.S.C. §102(b) over U.S. Patent No. 5,751,287 to Hahn et al. (Hahn). This rejection is respectfully traversed.

Claim 1 recites, *inter alia*, a thumbnail having at least one first selectable element and a second, separate selectable portion. When the second portion of the thumbnail is selected (e.g., the portion other than the first selectable element), an original document is provided as a first associated destination. When the first selectable element is selected, a second associated destination is provided that is one of (a) a portion of the original document smaller than the original document and (b) a document other than the original document. Claims 12 and 26 are similar. Thus, the thumbnail itself has two selectable parts (e.g., first selectable element and second selectable portion).

As the basis of the rejection, the Office Action asserts in the Advisory Action and Examiner Zhou argued during the interview that the user has the capability of selecting the

thumbnail as a whole to display the whole page associated with the thumbnail (Fig. 16 of Hahn) and selecting the thumbnail to display only a desired portion of the associated page (Fig. 17 of Hahn), and therefore, one of ordinary skill in the art would have been motivated to combine the embodiments.

First of all, Applicants respectfully submit that what is shown in Figs. 16 and 17 are two different, mutually exclusive embodiments. According to Hahn, as described at col. 11, lines 33-35, Fig. 16 illustrates a display of a document stored within a file cabinet according to "a" preferred embodiment. Hahn also describes at col. 12, lines 1-2 that Fig. 17 illustrates a display of a scanned document according to "a" preferred embodiment. Because each embodiment is referred as "a preferred embodiment," it is clear from its description that Hahn treats these as separate embodiments. In addition, although Figs. 16 and 17 of Hahn do show similar images, their use is intended to different purposes. Therefore, Applicants respectfully submits that the embodiment shown in Fig. 16 and the embodiment shown in Fig. 17 are two different embodiments. This is further evidenced because of the incompatibility of the two embodiments. In one Figure, selection of the thumbnail results in one destination being displayed while a separate function key remote from the thumbnail is required to display a different destination. In the other embodiment, the selection is reversed. However, both embodiments allow only a single display operation by selection of the thumbnail itself. Each requires additional structure to display the other destination or document.

Thus, the embodiments are mutually exclusive and not combinable because the thumbnail itself is only capable of selecting a single destination or document, and Hahn provides no teaching or suggestion of how the thumbnail could be modified to enable selection of two different objects through selection of different parts of the thumbnail.

Next, with respect to the Patent Office's assertion regarding the user's capability, Applicants respectfully submit that such capability is not a proper motivation for combining

the embodiments. Applicants respectfully assert that the mere fact that embodiments can or could be combined or modified does not render the resultant combination obvious unless the prior also suggests the desirability of the combination. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so" (emphasis added). See MPEP §2143.01 under "Fact That References Can Be Combined Or Modified Is Not Sufficient To Establish *Prima Facie* Obviousness."

Applicants respectfully submit that because Hahn does not teach or suggest the need or advantage of combining both embodiments, one of ordinary skill in the art would not have been motivated to combine the different embodiments of Hahn as claimed. Rather, Hahn, if anything, teaches against the claimed invention by showing that similar functionality can be achieved by using separate function keys or slide bars remote from the thumbnail to display additional representations of the original document rather than having multiple functionality within the thumbnail itself. Furthermore, it is believed that one of ordinary skill in the art would not have been able to create a thumbnail with the dual functionality as claimed based on Hahn's disclosure. Thus, Hahn is non-enabling for the Examiner's asserted combination.

Accordingly, Applicants respectfully submit that the rejection is improper, and therefore, claim 1 is patentably distinct from the applied prior art. Independent claims 12 and 26 recite similar features and are also patentably distinct for these same reasons.

Claims 2-3 and 13-14 are allowable at least for their dependence on allowable base claims, as well as for the additional features they recite.

Claim 4 recites, *inter alia*, that a thumbnail has a first selectable element that has, as an associated destination, one of (a) an arbitrary portion of the original document accessible by selection of a second selectable element provided in the original document and (b) a document other than the original document, and that the associated destination is directly

accessed based on a selection of the first selectable element without first accessing the original document. This feature is described in the specification at, for example, paragraph [0045] and clarifies the "directly accessed" feature consistent with prior arguments. Claim 4 is also amended to recite that the arbitrary portion is not positionally corresponding to the second selectable element. This amendment was suggested by the Examiners during the interview for clarification. Applicants respectfully believe that this amendment is merely for clarification of the claim language and is not intended to narrow the claim scope.

In other words, under (a), the original document includes both the second selectable element and the arbitrary portion, which is accessible from and not positionally corresponding to the second selectable element. By selecting the first selectable element provided in the thumbnail, the arbitrary portion in the original document can be directly accessed without first accessing the original document and then selecting the second selectable element.

In making the rejection, the Patent Office relies on a statement "However, even if the use[r] has to retrieve the selectable elements in the original document by selecting the corresponding section in the thumbnail first and then select the selectable element in the original document to access the arbitrary position..." This statement admits that Hahn does not teach or suggest directly accessing the associated destination (i.e., without first accessing the original document). Moreover, the position in Hahn does not correspond to the claimed arbitrary position as defined. Accordingly, Applicants respectfully submit that claim 4 is patentably distinct from Hahn.

Independent claims 15 and 27 recite features similar to those in claim 4 and are also patentably distinct from Hahn for the same reasons.

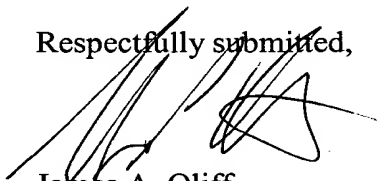
Claims 5-8 and 15-19 are allowable at least for their dependence on allowable base claims, as well as for the additional features they recite.

The rejections of claim 9-11, 20-22 and 28 are moot because these claims are cancelled without prejudice to or disclaimer of the subject matter therein by this Amendment.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Stephen P. Catlin  
Registration No. 36,101

JAO:SPC/al

Date: January 31, 2005

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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